

Remarks:

The present amendment is in response to the office action dated September 1, 2005 in the above-identified patent application.

In the office action, claims 1-19 were pending, with claims 1-19 being rejected. Claims 1, 4-17, and 19 remain in this application, with claims 1, 4, 5, 11, and 17 having been amended, and claims 2, 3, and 18 having been cancelled.

Summary of Examiner rejections and Applicant responses

In the office action on page 2 the Examiner rejected claims 1-19 under 35 U.S.C. 112, second paragraph, as being indefinite as claims 1-19 teach a roll member that is operational “to pivot parallel to said pivotal roll axis”, wherein the Examiner stated that a member is normally pivoted about an axis.

In response, claims 1, 11, and 17 are amended to delete “parallel to” and replace with “about”, also description paragraphs 83 and 90 are amended to delete “parallel to” and replace with “about” to provide support for the claim amendments. For antecedent support to change “parallel to” to “about”, it is obvious from Figures 1, 2, and 8 that the roll member 52 pivots about the pivotal roll axis 30 and that this amendment does not constitute new matter added to the application.

Turning to the rejections over the prior art the in the office action on page 2, the Examiner stated that claims 1, 2, 7-10, 17, and 19 are rejected under 35

Application No. 10/708,438

U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,467,350 to Tyler. The Examiner states that Tyler discloses a frame (20, 50), having a longitudinal axis (26), with the frame includes a first end (48) attached to a support structure (22) and a second end having a pivotal connection (at pin 78) having a pivotal roll axis (24); a roll member (16) adapted to attach to the camera (30), (column 4, lines 60-69). The Examiner also stated that the roll member has an extension arm (94) with longitudinal axis (96) that can be rotated about pin (98) with a distal end portion adjacent to a counter weight (36) that is operational to maintain the camera level in relation to frame roll movement by selectively positioning roll member, camera, extension arm, and weight for a selected center of mass all combined (column 6, lines 54-65), wherein the frame longitudinal axis and extension arm form a parallel to angular relationship, from Figure 1.

In response, claims 1, 4, 5, and 17 are amended and claims 2, 3, and 18 are cancelled.

Regarding claim 2, the Examiner states that Tyler teaches in Figure 18 dampener (50, 60, 62, 64, 66) that is positioned adjacent to both the frame (at 52 and 54) and roll member (at pin 78), where the dampener is operational to help control relative arbitrary pivotal roll movement of the frame to the roll member.

In response, the limitations of claims 2 and 3 are incorporated into claim 1 and claims 2 and 3 are cancelled.

Regarding claim 7, the Examiner states that Tyler teaches that the extension arm proximal end portion further comprises a fixedly adjustable

Application No. 10/708,438

element (94, 98) that allows the extension arm to selectively deviate from being approximately perpendicular to the pivotal roll axis, wherein the fixedly adjustable element accommodates a camera with an offset center of gravity (Column 6, lines 54 -65).

In response, claim 1 is amended and as claim 7 depends from amended claim 1, claim 7 is implicitly amended.

Regarding claim 8, the Examiner states that Tyler teaches that the fixably adjustable element includes an aperture (at pin 98) in the roll member that rotationally receives and axially retains the extension arm proximal end portion allowing a selected rotational position of the extension arm to be locked in place with the roll member lockable element (98) with the extension arm proximal end portion including a fixed angle portion as shown in Figures 1-3.

In response, claim 1 is amended and as claim 8 depends from claim 7 that depends from amended claim 1, claim 8 is implicitly amended.

Regarding claim 9, the Examiner states that Tyler teaches that the counterbalance weight is removably engagable from the extension arm distal end portion, and is operational to selectively change the amount of counterbalance weight that is operational to alter or maintain a selected position of the center of mass to accommodate different weight cameras (Column 5, lines 24-27).

In response, claim 1 is amended and as claim 9 depends from amended claim 1, claim 9 is implicitly amended.

Application No. 10/708,438

Regarding claim 10, the Examiner states that Tyler teaches that the counterbalance weight is movably engagable along the extension arm, being operational to selectively change the distance of the counterbalance weight from the roll member, allowing the ability to alter or maintain a selected position of the center of mass, to accommodate different weight cameras (Column 6, lines 54-65).

In response, claim 1 is amended and as claim 10 depends from amended claim 1, claim 10 is implicitly amended.

Regarding claim 17, the Examiner states that Tyler teaches a method of acquiring camera images that comprises the steps of: (a) providing a self-leveling camera support apparatus from Figures 1 and 3, as previously described; (b) attaching the frame to a support structure (22); (c) attaching the camera (30) to the roll member (16); (d) positioning a selected amount of counterbalance weight (36) to accommodate the camera weight (Column 6, lines 54-59); and (e) acquiring images of an event using the camera, however, using the apparatus to acquire aquatic event images would be obvious.

In response, claim 17 is amended and claim 18 is cancelled.

Regarding claim 19, the Examiner states that Tyler teaches a fixedly adjustable element (94, 98) that allows the extension arm to selectively deviate from being approximately perpendicular to the pivotal roll axis to accommodate the camera with an offset center of gravity by altering the position the center of mass (Column 6, lines 54-65).

Application No. 10/708,438

In response, claim 17 is amended and as claim 19 depends from amended claim 17, claim 19 is implicitly amended.

In the office action on page 6, to the Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,467,350 to Tyler, in view of U.S. Patent No. 5,190,256 to Macchiarella, the Examiner stated that Tyler teaches the invention of claim 1, except for the frame first end that includes an arcuate section configured to substantially conform to a portion of a marine vessel rail outside circumference, including a clamp pivotal element, and a clamp fastener. The Examiner further states that Macchiarella teaches a camera support apparatus wherein the frame first end (22) is adapted to attach to a support structure as shown in Figure 8 and that would of been obvious to one with ordinary skill in the art at the time of the applicant invention to modify Tyler to include a rail clamp structure to take stabilized images of the water skier while on a boat as taught by Macchiarella (Column 1, lines 41-43).

In response, claim 1 is amended and as claim 6 depends from amended claim 1, claim 6 is implicitly amended.

Detailed explanation of reference teachings and amendment remarks

A 35 U.S.C. 102(b) rejection requires complete claim anticipation by a single reference, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d

Application No. 10/708,438

628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Also, "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Plus, the elements must be arranged as required in the claim, however, identical terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Tyler teaches in referring specifically to Figure 4 utilizing member 50, a biasing spring 60, resting against a retainer 64 and a biasing spring 58 resting against a retainer 62 that all act to sandwich or compress axially along axis 26 the spacer 70 and inner race of a conventional ball bearing 76 through washer 74 and washer 72 to allow a free pivoting connection about axis 26 of the coupling 78 and member 66, column 4, lines 55-61. It can be observed that with this axial compression along axis 26 that the inner race of the ball bearing 76 is axially frictionally clamped and centered on pin 68, also that more specifically member 66 being attached to the ball bearing 76 outer race is allowed to pivotally rotate freely about axis 26 as member 66 does not in any way contact the spring retainer 64 or the spring retainer 62. Further, in referring to Figure 4 again as evidence that Tyler has no teaching with regard to the pivotal movement dampening about axis 24, the ball bearings 82 and 84 are also clamped on their inner races by nut 88 as against coupling 78, thus allowing free pivotal movement of arm 86 about axis 24. Continuing, in referring to Figure 5 there is also free pivotal movement about axis 34 again as evidenced by the clamping of

Application No. 10/708,438

ball bearing 140 on its inner race by stud portion 146 wherein arm 134 freely pivots about axis 34, similarly, there is also free pivotal movement about axis 32 as ball bearings 128 are again clamped on their inner races by pin 130 allowing free pivotal movement of assembly 18 about axis 32 with the movement about axis 32 being able to locked into a vertical position of the camera 30 through the use of separately positioned knob 138 and nut 136 that do not function as a pivotal movement dampening about axis 32, but merely as a selected position lock of pivotal movement about axis 32, reference column 5, lines 45-48. Finally, in reference to pivotal movement about axis 102, Tyler teaches only the use of arm 92 and arm 86 that are pivotally connected relative to one another about axis 102, again there is no teaching related to dampening of pivotal movement about axis 102. Referring specifically to column 6, lines 15-26 Tyler makes a very brief and nonspecific reference to use of frictional clutch devices that can be utilized to provide a very slight frictional drag between the components during operation of the mount 16, Tyler provides no specific enablement in this area, thus ordinary skill in the art would have to be relied upon to allow for teaching of the simple use of a frictional clutch to restrict movement about one or more of the aforementioned pivotal axes. Thus, it is ordinary skill in the art that frictional clutch dampening has a large degree of a dampening control inability as the coefficient of friction varies greatly between components that are static to one another and components that are dynamic to one another, thus frictional dampening would not allow a smooth dampening process that would be viscous

Application No. 10/708,438

in nature (such as fluid dampening) nor easily adjustable as with the use of clutch friction devices for dampening would provide a high degree of stiction, stickiness, or high resistance in the initial pivotal movement as a clutch device would have a higher static coefficient of friction allowing for a jerk to initial pivotal movement wherein the subsequent dynamic coefficient of friction of the clutch device would be much reduced once the pivoting movement commenced, this would be very highly undesirable in the use of a camera mount as the initial jerk in pivotal movement as previously described would result in a jerky movement at the camera lens and thus would be unacceptable. Thus, Tyler does not teach an acceptable dampening of any of the aforementioned pivotal movements. In summary, for Tyler the camera operator themselves is relied upon as a major component in dampening movement of the camera as the operator is integral part of the camera movement relative to the frame and Tyler does not operate in a non camera operator mode, i.e. the camera operator is always required for Tyler to function per the disclosed principal of operation, thus Tyler is not a self contained pivotal camera mount apparatus. One other item of note is that Tyler confuses bias with dampening, referring specifically to column 2, lines 65-70, bias and dampening are two completely different kinetic movements as bias defaults movement to fixed position with no restriction on the speed of the movement, wherein dampening restricts any and all movement to a fluid like motion, wherein dampening does not bias movement at all to a default fixed position.

Application No. 10/708,438

Turning to the rejections over the prior art the in the office action on page 2, the Examiner stated that claims 1, 2, 7-10, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,467,350 to Tyler. The Examiner states that Tyler discloses a frame (20, 50), having a longitudinal axis (26), with the frame including a first end (48) attached to a support structure (22) and a second end having a pivotal connection (at pin 78) having a pivotal roll axis (24); a roll member (16) adapted to attach to the camera (30), (column 4, lines 60-69). The Examiner also stated that the roll member has an extension arm (94) with longitudinal axis (96) that can be rotated about pin (98) with a distal end portion adjacent to a counter weight (36) that is operational to maintain the camera level in relation to frame roll movement by selectively positioning roll member, camera, extension arm, and weight for a selected center of mass all combined (column 6, lines 54-65), wherein the frame longitudinal axis and extension arm form a parallel to angular relationship, from Figure 1.

In response, claims 1, 4, 5, and 17 are amended and claims 2, 3, and 18 are cancelled.

Regarding claim 2, the Examiner states that Tyler teaches in Figure 18 dampener (50, 60, 62, 64, 66) that is positioned adjacent to both the frame (at 52 and 54) and roll member (at pin 78), wherein the dampener is operational to help control relative arbitrary pivotal roll movement of the frame to the roll member.

In response, the limitations of claims 2 and 3 are incorporated into claim 1 and claims 2 and 3 are cancelled. The Examiner is directed to the detailed

Application No. 10/708,438

teachings of Tyler previously described as specifically enumerated in Figures 3, 4, and 5 wherein there is nothing disclosed related to dampening of pivotal movement along axes 26, 24, 102, 34, and 32 wherein all the aforementioned pivotal movement is accomplished by the use of freely rotating ball bearings. Tyler makes a brief comment related to clutch devices in column 6, lines 15-26, only disclosing the possible use frictional drag at the previously mentioned pivotal connections, although noting that to maintain Tyler's principal of operation the camera operating individual must be utilized in the mount 16, thus the camera operating individual adds a component of dampening to all of Tyler's pivotal connections. Therefore, Tyler does not really teach a total composite dampening for a self-contained camera mount apparatus, i.e. without the uncertain effects of the camera operator's dampening of pivotal movement, this coupled with the very unspecific use of frictional clutch devices (which are not really appropriate for dampening camera movement) results in Tyler not teaching pivotal axis fluid dampening for a self-contained camera mount to the degree that someone with ordinary skill in the art could make and use the invention. Due to this, Applicant's claim 1 is amended to incorporate a dampener that is of a piston and cylinder type for an appropriate level of "fluid" dampening of the camera pivotal movement, of which Tyler does not teach, thus amended claim 1 and its dependent claims 2, 7, 8, 9, and 10 should overcome the 35 U.S.C. 102 (b) rejection.

Application No. 10/708,438

Regarding claim 7, the Examiner states that Tyler teaches that the extension arm proximal end portion further comprises a fixedly adjustable element (94, 98) that allows the extension arm to selectively deviate from being approximately perpendicular to the pivotal roll axis, wherein the fixedly adjustable element accommodates a camera with an offset center of gravity (Column 6, lines 54 -65).

In response, claim 1 is amended and as claim 7 depends from amended claim 1, claim 7 is implicitly amended.

Regarding claim 8, the Examiner states that Tyler teaches that the fixably adjustable element includes an aperture (at pin 98) in the roll member that rotationally receives and axially retains the extension arm proximal end portion allowing a selected rotational position of the extension arm to be locked in place with the roll member lockable element (98) with the extension arm proximal end portion including a fixed angle portion as shown in figures 1-3.

In response, claim 1 is amended and as claim 8 depends from claim 7 that depends from amended claim 1, claim 8 is implicitly amended.

Regarding claim 9, the Examiner states that Tyler teaches that the counterbalance weight is removably engagable from the extension arm distal end portion, being operational to selectively change the amount of counterbalance weight that is operational to alter or maintain a selected position of the center of mass to accommodate different weight cameras (Column 5, lines 24-27).

Application No. 10/708,438

In response, claim 1 is amended and as claim 9 depends from amended claim 1, claim 9 is implicitly amended.

Regarding claim 10, the Examiner states that Tyler teaches that the counterbalance weight is movably engagable along the extension arm, being operational to selectively change the distance of the counterbalance weight from the roll member, by allowing the ability to alter or maintain a selected position of the center of mass, to accommodate different weight cameras (Column 6, lines 54-65).

In response, claim 1 is amended and as claim 10 depends from amended claim 1, claim 10 is implicitly amended.

Regarding claim 17, Examiner states that Tyler teaches a method of acquiring camera images that comprises the steps of: (a) providing a self-leveling camera support apparatus from Figures 1 and 3, as previously described; (b) attaching the frame first into a support structure (22); (c) attaching the camera (30) to the roll member (16); (d) positioning a selected amount of counterbalance weight (36) to accommodate the camera weight (Column 6, lines 54-59); and (e) acquiring images of an event using the camera, however, using the apparatus to acquire aquatic event images would be obvious.

In response, claim 17 is amended and claim 18 is cancelled. As previously discussed, Tyler does not teach fluid dampening (either structure or the use of) for the camera on a self-contained pivotal camera mount apparatus, thus claim 17 is amended to incorporate a fluid dampener in the providing step

Application No. 10/708,438

(a) in addition to amending claim 17 to add a step after the current positioning step (d) to adjust the dampener resistance to further control the relative arbitrary pivotal roll movement of the frame to the roll member, which is the incorporation of claim 18 limitations into claim 17 resulting in the cancellation of claim 18. As Tyler does not teach the use of fluid dampening for a self-contained camera apparatus, amended claim 17 and its remaining dependent claim 19 should now overcome the 35 U.S.C. 102(b) rejection.

Regarding claim 19, the Examiner states that Tyler teaches a fixedly adjustable element (94, 98) that allows the extension arm to selectively deviate from being approximately perpendicular to the pivotal roll axis to accommodate the camera with an offset center of gravity by altering the position the center of mass (Column 6, lines 54-65).

In response, claim 17 is amended and as claim 19 depends from amended claim 17, claim 19 is implicitly amended.

In establishing a *prima facie* case of obviousness under 35 U.S.C. 103 it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been lead to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the Applicant's disclosure. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*,

Application No. 10/708,438

837 F.2d 1044, 1052, 5 USPQ2d 1434 (Fed. Cir. 1991) (The teaching or suggestion to make the claimed combination must not be based on the Applicant's disclosure). For a proper rejection under 35 U.S.C. 103 all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging patentability of that claim against the prior art."). Obviousness under 35 U.S.C. 103 can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998). The proposed modification for combining or individually modifying the prior art references cannot change the principal of operation of the references, if the principal of operation of the references is changed, then the teachings of the references are not sufficient to render the claim *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The motivation to modify the reference should manifest in some advantage or beneficial result, *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). Further, it should be noted that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is

Application No. 10/708,438

nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.03.

Macchiarella teaches a camera support adapted to attach to a water ski boat that has the capability of laterally pivoting to track a water skier's lateral positional movement behind the water ski boat. Of particular interest, and specifically referring to Figures 3 and 8, a stationary means is disclosed in the form of a clamp 20 that fastens to a water ski boat pylon through the form of a common compression clamp to secure the camera support to the water ski boat. In addition, Macchiarella teaches away from pivotal movement dampening as the water skier moves rapidly laterally or side to side behind the water ski boat, column 1, lines 23-30, thus requiring the pivotal camera mount apparatus to pivot rapidly to allow the camera to track the water skier behind the water ski boat in accord with the desired principal of operation for Macchiarella.

In the office action on page 6, to the Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,467,350 to Tyler, in view of U.S. Patent No. 5,190,256 to Macchiarrella, the Examiner stated that Tyler teaches the invention of claim 1, except for the frame first end that includes an arcuate section configured to substantially conform to a portion of a marine vessel rail outside circumference, including a rail clamp pivotal element, and a rail clamp fastener. The Examiner further states that Macchiarella teaches a camera support apparatus wherein the frame first end (22) is adapted to attach to a support structure as shown in Figure 8 and that would of been obvious to one

Application No. 10/708,438

of ordinary skill in the art at the time of the applicant invention to modify Tyler to include a rail clamp structure to take stabilized images of the water skier while on a boat as taught by Macchiarella (Column 1, lines 41-43).

In response, claim 1 is amended and as claim 6 depends from amended claim 1, claim 6 is implicitly amended. As previously discussed the claim 1 amendment adds fluid dampening to pivotal camera movement for a self-contained pivotal camera support apparatus which is not taught by either Tyler or Macchiarella. In addition, it would be difficult to understand how there would be a motivation, suggestion, or teaching to combine Tyler and Macchiarella to add the marine vessel rail support of Macchiarella to Tyler that is adapted to attach to a marine vessel rail outside circumference as Tyler's principal of operation in using an individual camera operator to selectively position the camera, wherein the camera operator is seated on the supporting platform 22 of Tyler would not lend itself to modify the supporting platform 22 to be adapted to attach to a marine vessel rail outside circumference and still being able to utilize the necessary individual camera operator in their desired position for the use of Tyler's camera mount. Thus, modifying Tyler to incorporate the camera mount of Macchiarella would destroy Tyler's principal of operation resulting in an implicit teaching away from the aforementioned combination of Tyler and Macchiarella. Thus, the implicit amendment of claim 6 should overcome the 35 USC 103 (a) rejection.

Application No. 10/708,438

Applicant respectfully requests that a timely notice of allowance be issued in this case.

Respectfully submitted,

Roger A. Jackson, Esq.

BY:



Roger A. Jackson
Registration No. 44,797
Customer No. 24254
800 Pennsylvania, Suite 1504
Denver, Colorado 80203-3185
USA
Phone: (303) 271-9468
Fax: (303) 216-2967
Email: rogerjackson@ricochet.com
Website: www.jacksonesquire.com

Application No. 10/708,438



CERTIFICATE OF MAILING UNDER 37 C.F.R §1.8

I hereby certify that the attached **TRANSMITTAL OF RESPONSE TO
OFFICE ACTION DATED SEPTEMBER 1, 2005 AND RETURN RECEIPT
POST CARD** is being deposited with the United States Postal Service as prepaid
first class mail in an envelope addressed to Mail Stop Amendment,
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1st
day of February, 2006.

Roger A. Jackson

A handwritten signature in black ink, appearing to read "Roger A. Jackson", is written over a solid horizontal line.